

REMARKS

Claims 17, 21, 22, 26, 30, 31, and 35-38 are amended. Claims 17-38 are now pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application. Each issue raised in the Office Action mailed August 27, 2008 is addressed hereinafter, in order of appearance.

I. ISSUES NOT RELATING TO PRIOR ART

A. CLAIMS 17-38

Claims 17-38 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Within various claims, the claimed terms “e-mail client” and “instant messaging client” have been amended to now read “e-mail application” and “instant messaging application”. Consequently, the rejection of Claims 17-38 under 35 U.S.C. § 112 is unsupported and should be withdrawn.

B. IDS NOT INITIALED

Applicant also inquires as to why various IDS papers have not been initialed. Specifically, Applicant inquires about an IDS page referring (near the top of the page) to a U.S. Patent to Olshansky et al, and referring to a foreign patent to Bloch (lower down on that page). Applicant makes the same inquiry about an IDS page with a single non-patent literature entry “Communication Pursuant to Article 94(3) received June 17, 2008”. In both cases, Applicant inquires as to why these were not initialed, and exactly what is the problem therein.

II. ISSUES RELATING TO PRIOR ART

A. CLAIMS 17-38

Claims 17-38 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Berstis et al (US Patent 7,089,194). The rejection is respectfully traversed.

Claim 17 recites, inter alia, “storing, remote to a client, user specific data . . . [which] . . . is collected by a search website that provides searching functionality related to a search initiated by a user.” Claim 26 recites similar subject matter. The Office Action (page 3) relies on Berstis’ downstream scanner unit 422 scanning the content of the datastream and generating browse history information 424 (col. 7 lines 1-3) to anticipate this portion of Claim 17. However, Berstis does not disclose use of a search website at all, and certainly does not disclose a search “initiated by a user”.

Berstis makes decisions about which of a group of advertisement to display, where those decisions are based on **a user’s browse history information**. Berstis is entirely silent as to what type of sites its users are visiting, whether search or non-search. Further, even if some of those previously visited sites happen to be search sites, Berstis does not disclose or even suggest using information “**collected by**” the search website as a basis for selecting the advertisements.

For at least the above reasons, the rejections of Claims 17 and 26, as well as all claims dependent therefrom, are unsupportable and should be withdrawn.

### III. CONCLUSIONS & MISCELLANEOUS

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by e-mail or telephone relating to any issue that would advance examination of the present application. As per MPEP Chapter 5, Applicant acknowledges that Internet communications may not be secure.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee and other applicable fees is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: November 20, 2008

/ChristopherMTanner#41518/  
Christopher M. Tanner  
Reg. No. 41,518

ctanner@hptb-law.com  
2055 Gateway Place Suite 550  
San Jose, California 95110-1093  
Telephone No.: (408) 414-1238  
Facsimile No.: (408) 414-1076